

Notice of Allowability

Application No.

09/787,613

Examiner

Zachary C. Tucker

Applicant(s)

ISAK ET AL.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 17 September 2003.
2. ☒ The allowed claim(s) is/are 1-4.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other _____ |

Response to Appeal

The Appeal Brief, filed 17 September 2003, has been studied.

Status of Claim Rejections - 35 USC § 102

In the previous Office action, dated 13 June 2003 (paper 12), claims 1-4 were rejected under 35 U.S.C. 102(b) as being anticipated by US 3,420,851 (Bloom et al).

Upon consideration of the arguments presented in the Appeal Brief, the rejection is hereby withdrawn.

The reason the rejection based on Bloom et al has been withdrawn is that Bloom et al's Example 1 discloses a phenoxymethyl benzoic acid which has been dried with anhydrous sodium sulfate (to remove water), and then benzene is removed by evaporation, before the first melting point determination. Though Bloom et al does not report an evaporation to remove residual solvent after the recrystallization from ethanol before the second melting point determination, one cannot fairly make the assertion that the sample during the second melting point determination contained the requisite at least 0.1% solvent therein during the heating step.

Bloom et al's samples were already dry of water and solvent and therefore could not be dried by the melting point determinations.

Status of Claim Rejections - 35 USC § 112

In the previous Office action, claims 1-4 were rejected under U.S.C. 112, second paragraph, for indefiniteness.

Applicants' arguments traversing the indefinite in the Appeal Brief filed 17 September 2003 are persuasive, and therefore the rejection is withdrawn.

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It is now agreed that one of ordinary skill in the art would be apprised of the scope of the claims. The melting point range of a compound or a mixture of compounds is a measurable physical constant.

Allowable Subject Matter

Claims 1-4 are allowed.

The following is an examiner's statement of reasons for allowance:

All previously stated rejections are withdrawn.

An updated search has not afforded any disclosure of the instantly claimed drying process, or any disclosure rendering the invention obvious.

Almost invariably, when the melting point range of phenoxymethylbenzoic acids is reported in the literature, it follows treatment with some drying agent (usually anhydrous sodium sulfate) and/or evaporation of solvent under reduced pressure at a temperature substantially below the melting point of the phenoxymethylbenzoic acid. In cases where a drying and/or evaporation is not disclosed, the moisture or solvent content of the product material is not reported. To be sure, one of ordinary skill in the art would not be motivated to determine the melting point of a sample that contained a substantial amount of water and/or solvent, because the melting point would not be an accurate melting point for the phenoxymethylbenzoic acid.

Melting point determinations of phenoxymethylbenzoic acids reported in the prior art, therefore, do not read on the instantly claimed process.

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Furthermore, and perhaps most importantly, no express disclosure of drying a water- and/or solvent-wet phoxymethylbenzoic acid by heating it at least 1° above its melting point has been found in the prior art.

Cited of Interest

Two disclosures, GB 733,594 and GB 950,717 (with Bloom et al) serve to illustrate known work-up, purification and drying procedures for phoxymethylbenzoic acids (Examples in both references).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

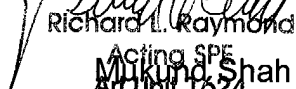
All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-308-5083, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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